

GP 1615

CASE 47-19658/A

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Art Unit: 1615

BRUGGER ET AL.

Examiner: R. Bawa

APPLICATION NO: 08/288,415

FILED: AUGUST 10, 1994

FOR: AN AEROSOL CONTAINER AND A METHOD FOR STORAGE AND
ADMINISTRATION OF A PRE-DETERMINED AMOUNT OF A
PHARMACEUTICALLY ACTIVE AEROSOL

Assistant Commissioner for Patents
Washington, D.C. 20231

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REPLY BRIEF

Sir:

In response the Examiner's Answer mailed August 1, 2000, Appellants respectfully submit this Reply Brief in triplicate. Consideration of the same on appeal is earnestly solicited.

(1) Gennaro is completely silent as to whether the coatings he lists are capable of inhibiting the deposition of pharmaceutically active agents on the interior of a can. Gennaro is completely silent as to whether it is even *desirable* to prevent pharmaceutically active agents from depositing on the inside of a can. The Examiner's Answer ignores these uncontested facts by equating Gennaro's generic description of a "protective coating" to Appellants' specific recitation of a "coating which inhibits the pharmaceutically active agent in the suspension from depositing" on the container wall. See Appellants' claim 15. The generic disclosure of a "protective coating" specifically described by Gennaro to prevent corrosion or reaction on the container walls does not meet Appellants' invention as claimed. In view of Gennaro's silence regarding deposition of pharmaceutically active agent on the container walls, and Gennaro's silence as to whether it is desirable to prevent such deposition, it is impossible that Gennaro would have motivated the skilled artisan to modify any can disclosed

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by Gennaro to prevent such deposition. Accordingly, the rejection provides only a hindsight interpretation of Gennaro based on Appellants' claims rather than any disclosure within Gennaro.


(2) The Examiner's Answer further states that "[t]he above-mentioned claims are directed towards a composition contained in an aerosol can; its future intended use or administration is not at issue from a patentability point of view." Appellants disagree that this conclusory statement can be used as a device to ignore the recitation that the composition within the can comprises "a plastics coating which inhibits the pharmaceutically active agent in the suspension from depositing" on the container wall. There is no indication in the prior art or on the record that Gennaro's generic list of "protective coatings" would meet this limitation. MPEP 2143.03 is clear. The prior art must teach or suggest every limitation of an applicant's claims. The recitation in the body of Appellants' claims defining the composition of the recited coating cannot be disregarded "from a patentability point of view" by simply characterizing that recitation as a "future intended use or administration."

For at least these reasons and the reasons set forth in Appellants' Appeal Brief, reversal of the rejection and early allowance of the application are respectfully requested.

If there are any fees due in connection with this communication, including any fees for a required extension of time, such an extension is requested and the Commissioner is authorized to charge the fees to Deposit Account No. 19-0134 in the name of Novartis Corporation.

Respectfully submitted,

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10/2/2000